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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/734,803	12/12/2000	Maurice Raymond Hickling	20526/111695	5200

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EXAMINER

GOLLAMUDI, SHARMILA S

ART UNIT	PAPER NUMBER
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1616

DATE MAILED: 02/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/734,803

Applicant(s)

HICKLING, MAURICE RAYMOND

Examiner

Sharmila S. Gollamudi

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 October 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

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DETAILED ACTION

Receipt of Amendment to Claims and Rule 132 Declaration received on October 3, 2003 is acknowledged. Claims 1-12 are pending in this application.

Response to Amendment

The Declaration under 37 CFR 1.132 filed October 3, 2003 is insufficient to overcome the rejection of claim Ribier et al (US 5,756,108) as set forth in the last Office action because: The applicant asserts that the manipulation of Ribier's phytantriol to dispersing agent is not obvious wherein the amount of dispersing agent is greater than phytantriol because cubic gel particles cannot be formed under these conditions and this is critical to Ribier's invention. The applicant asserts that the cubic gel particles will not form unless a high-energy mixer is utilized and a ratio of 1:1 is utilized.

The examiner notes that the declaration merely recites Ribier's examples to demonstrate the formation of cubic gel particles to come to the conclusion that manipulating the amounts is not possible. However, the examiner points out that Ribier et al discloses 0.1-15% of phytantriol and 0.0-3% of a dispersing agent. Thus, it is within the scope of Ribier that one can use a low amount of phytantriol (0.1%) and a high amount of the dispersing agent (3%) as seen in the amendments of October 30, 2003. Therefore, to make an assertion that Ribier's formulation is not manipulable, the applicant must utilize the lower limit of Ribier's phytantriol, i.e. 0.1% and the maximum limit of Ribier's dispersing agent; i.e. 3% to demonstrate that the cubic particle cannot be formed. However, applicant has not done this.

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Secondly, the declaration states that a high mixer is necessary to make the cubic particles and instant invention does not; however the process claim does not exclude this step. In regards to the ratio, the applicant asserts that cubic gel particles require a greater than 1:1 ratio of polar lipid: water and Ribier teaches a 3.15:1 ratio. The examiner points out that the Ribier's 3.15:1 ratio is phytantriol to dispersing agent not phytantriol to water.

Further, the declaration states that the two compositions are physically different such as viscosity, particle sizes, appearance, etc. However, the examiner points out that these features are not recited in the instant claims and cannot be relied upon to distinguish over Ribier et al.

Response to Arguments

Applicant argues that the Ribier et al exemplifies a ratio wherein phytantriol is in a greater amount than the dispersing agent. It is argued that Ribier's formulations cannot be manipulated. Applicant argues that Saphakkul and Wenke does not remedy Ribier since the Rule 132 Declaration shows that Ribier's amounts cannot be manipulated. It is argued that the examiner provides no motivation for the use of Wenke's dyes in Ribier's. It is further argued that the examiner has not provided evidence that Wenke's disclosed dopa species would work in a cubic particle gel and would survive the intensity of mixing.

Applicant's arguments have been fully considered but they are not persuasive. The examiner has already addressed the Rule 132 declaration amount above. The prior art and the instant invention claim overlapping ranges wherein it is possible for Ribier's

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formulation to contain more dispersing agent. It is applicant's burden to shown that manipulating the agents cannot form the critical aspect of Ribier's invention, i.e. the cubic particles. In order to do this, the applicant must compare the lower limit of phytantriol and the maximum limit of the dispersing agent. Without this comparison, the applicant is not substantiating the assertion that cubic particles cannot be formed if the dispersing agent is more than the phytantriol.

Secondly, the examiner points out that the disclosed examples and preferred embodiments such the ratio, do not constitute a teaching away from a broader disclosure or nonpreferred embodiments. Therefore, it is clear that instant claims fall within the scope of the instant claims.

In regards to Wenke, the rejection in the prior Office Action clearly set forth the motivation. Ribier clearly allows for the incorporation of semi-permanent and permanent hair dyes and Wenke teaches these dyes in a hair kit formulation. The motivation to combine being that the hair kit allows for easy application and use of the product with higher consumer appeal. Further, Wenke teaches the use of semi permanent, permanent, and basic dyes. Therefore, there is a clear expectation of success. Furthermore, it is pointed out that *it is the burden of the applicant* to demonstrate that Wenke's dyes are not operable in Ribier's composition since the USPTO does not have access to laboratories and chemicals. Lastly, the examiner points out that the applicant is broadly claiming hair dyes without any criticality and therefore applicant's scope does not exclude Wenke's dyes.

Claim Rejections - 35 USC § 112

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The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-8 and 10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Applicant has amended the independent claim 1 to recites "wherein the amount of the dispersing agent is greater than the amount of phytantriol". However, the claim also recites that 0.1-5% of phytantriol and 0.1-3% of dispersing agent. Therefore, the claims are indefinite since the scope clearly allows for phytantriol to be in a greater amount than the dispersing agent. Furthermore, claim 2 also recites a greater amount of phytantriol than the dispersing agent, which contradicts the parent claims' s limitation of "wherein the amount of the dispersing agent is greater than the amount of phytantriol". Claim 10 is indefinite since also recites a greater amount of phytantriol than the dispersing agent, which contradicts the parent claims' s limitation of "wherein the amount of the dispersing agent is greater than the amount of phytantriol".

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-8 and 11-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ribier et al (5,756,108) in view of Saphakkul (4,964,874).

Ribier et al disclose a cosmetic or dermatological composition containing an aqueous phase and an oily phase dispersed within. The reference teaches that although emulsions are easy to apply and impart good sensory properties, emulsion lack stability causing phase separation. Although this phase separation is prevented by the use of surfactant, excessive amounts of surfactants causes skin irritations. Ribier teaches that the use of phytantriol cubic particles provides stability and less irritation since the cubic gel particles requires less surfactant. See column 1, lines 5-40. The composition contains 0.1-15% of a component such as phytantriol and 0.05-3% of a dispersing agent. Polysorbate 20 is taught as a dispersing agent. See column 3, lines 59. Ribier et al teach natural dyes, oxidation couplers and bases (permanent dyes), direct dyes (semi-permanent dyes), and auto-oxidizable dyes. See column 7, lines 14-15. Ribier et al disclose the process of mixing the phytantriol in a dispersing agent and an active ingredient. Further, the reference discloses the application of the composition on the area that is to be treated.

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Ribier et al do not specify the type of direct dye that can be used or the amount.

Saphakkul teaches a hair treatment product. The reference teaches utilizes direct dyes such as anthraquinones for the coloring the hair. The color uptake by the hair is rapid and achieves moderate darkening when these dyes are used. Column 1, lines 15-50. Several anthraquinone dyes imparting different colors and the amount used (.001-0.5%) are taught on column 3.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings Ribier et al and Saphakkul and includes and anthraquinone dye into Ribier's composition. One would be motivated to do so since Saphakkul discloses that anthraquinone dyes are direct dyes that impart semi-permanent color to the hair and are rapidly taken up by the hair. Furthermore, one would expect similar results since Ribier teaches the suitability of direct dyes into the composition.

Claims 1-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ribier et al (5,756,108) in view of Wenke et al (5,628,799).

As set forth above, Ribier et al disclose a cosmetic or dermatological composition containing an aqueous phase and an oily phase dispersed within. See column 1, lines 5-40. The composition contains 0.1-15% of a component such as phytantriol and 0.05-3% of a dispersing agent. Polysorbate 20 is taught as a dispersing agent. Ribier et al teach natural dyes, oxidation couplers and bases (permanent dyes), direct dyes (semi-permanent dyes), and auto-oxidizable dyes. See column 7, lines 14-15. Although Ribier et al teach permanent hair dye as an active, Ribier et al do not teach a specific hair dye

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kit where the primary reactor (oxidizing agent) and secondary reactor (coupler) are in separate packs.

Ribier et al do not teach the amount of hair dye in the composition or a hair dye kit.

Wenke et al disclose a hair dye kit in which the oxidizing agent and a coupler are premeasured in different containers and mixed together by the user. See column 11 and 12 line 65 through 10. This premeasurement facilitates the correct use by the consumer; therefore no special expertise is required for the process. See column 3, lines 59-67. Furthermore, the kit allows for in-home use and is shelf-stable. See column 3, lines 60-67. Wenke et al disclose the instant amount of oxidizing agent and coupler. See column 13, lines 38-52. Wenke teaches that after applying the composition the color remained essentially unchanged after several cycles of shampooing. See example 66.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Ribier et al and Wenke et al and provide for a hair dye kit. One would be motivated to do so Wenke et al teach the advantages of using a kit to provide permanent hair color such as correct use by the consumer and in-home use. Furthermore, one would expect similar results since Ribier et al teach utilizing permanent dyes with an oxidizing and coupling agent. Lastly, one would be motivated to use the permanent hair dye of Wenke since Wenke teaches that the hair dyes provides color durability during repeated shampoos.

Claims 1-2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vinski et al (5,776,443).

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Vinski et al teaches a hair care composition that improves conditioning and stylability. The composition contains 0.001-1% phytantriol, preferably from 0.01-0.5%, and optimally from 0.05-0.2%. See column 2, lines 1-13. The composition further contains surfactant material such nonionic surfactants from the range of 1-40%, preferably from 2-35%, and optimally from 3-5%. See page 3, lines 65-67. Other ingredients that may be added in minor amounts are dyes, coloring agents, etc. see column 4, lines 14-15.

Vinski et al does not exemplify the composition.

It is deemed obvious to one of ordinary skill in the art at the time the invention was made to manipulate the amounts contained in Vinski et al to yield the instant composition containing phytantriol in an amount of less than the dispersing agent. One would be motivated to do so since Vinski teaches that acceptable and suitable ranges of both phytantriol and dispersing agent. Further, Vinski's optimal ranges teach the amount of dispersing agent is more than the amount of phytantriol. In regards to the amount of coloring agent, Vinski teaches minor amounts of coloring agents, which falls within the instant lower limit of 0.1%.

Claims 1-8 and 11-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vinski et al (5,776,443) in view of Saphakkul (4,964,874).

Vinski et al teaches a hair care composition that improves conditioning and stylability. The composition contains 0.001-1% phytantriol, preferably from 0.01-0.5%, and optimally from 0.05-0.2%. See column 2, lines 1-13. The composition further contains surfactant material such nonionic surfactants from the range of 1-40%,

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preferably from 2-35%, and optimally from 3-5%. See page 3, lines 65-67. Other active ingredients that may be added in minor amounts are dyes, coloring agents, etc. see column 4, lines 14-15.

Vinski et al does not specify the dye utilized in the composition.

Saphakkul teaches a hair treatment product for conditioning the hair. The reference teaches utilizes direct dyes such as anthraquinones for the coloring the hair for rapid even color. The color uptake by the hair is rapid and achieves moderate darkening when these dyes are used. Column 1, lines 15-50. Several anthraquinone dyes imparting different colors and the amount used (.001-0.5%) are taught on column 3.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teaching of Saphakkul and Vinski and utilize instant basic dyes since both references are directed towards conditioning the hair in a short time. One would be motivated to do so since Saphakkul teaches that the instant basic dyes allow for rapid coloration within a few minutes. Therefore, one would be motivated to add the basic dye into Vinski et al's composition to provide coloration within a few minutes.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

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§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

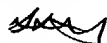
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sharmila S. Gollamudi whose telephone number is (703) 305-2147. The examiner can normally be reached on M-F (7:30-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman Page can be reached on (703) 308-2927. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3014.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

Sharmila S. Gollamudi


January 30, 2004


MICHAEL G. HARTLEY
PRIMARY EXAMINER

MICHAEL G. HARTLEY
PRIMARY EXAMINER